

**REMARKS**

In an Office Action dated November 6, 2002, with respect to United States Patent Application Number 09/961,595, the Examiner rejected cancelled Claims 3, 7, 16-21 and 24 stating:

Claims 3, 7, 16-21 and 24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a filter mounted to a base and having a gas component stacked thereon, does not reasonably provide enablement for the other elements to function in the same way. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate with the scope of these claims.

Applicant respectfully submits that Claims 32-47 are enabled because the disclosure in the specification and the examples provided therein would allow one of ordinary skill in the art to stack a variety of gas components without undue experimentation.

**A. A Single Embodiment Can Enable Broader Claims**

As the Examiner is aware "the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation." *In re Wright*, 999 F.2d 1557, 1561. The scope of the claims must be commensurate with the scope of enablement. *In re Bowen*, 492 F.2d 859, 861 (CCPA. 1974). In arts where the technology is predictable, such as electrical or mechanical arts, broad claims can be enabled by disclosure of a single embodiment, *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir. 1987), because "once imagined, other embodiments may be fashioned without undue experimentation," *Penda Corporation v. United States*, 29 Fed. Cl. 533, 556 (Fed. Cl. 1993) (citing, *Fisher* 427 F.2d 833, 839 (CCPA 1970)). See also, MPEP 2164.03, *In re Cook*, 439 F.2d 730, 734 (CCPA 1971). Therefore, the amount of required disclosure is inversely proportional to the predictability in the art, see MPEP 2164.03, and an applicant is not required to describe every conceivable embodiment of an invention, see *United States v. Teletronics*,

*Inc.*, 857 F.2d 778, 786 (Fed. Cir. 1988) (citing *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985).

The specification, as the Examiner has noted in the parent case, is enabling with respect to a filter mounted to a base and having a gas component mounted thereon. One such embodiment of this is described in conjunction with Figures 2 and 3, which disclose a filter and pressure transducer mounted to a modular base. Another embodiment is disclosed in conjunction with Figure 5, which shows a regulator and a filter mounted on a modular base. These examples are provided as preferred embodiments of the invention. The specification specifically discloses, however, that other components can be substituted for the filter and pressure transducer, including, but not limited to, gas filters, gas purifiers, pressure transducers, mass flow controllers, displays, moisture monitors, gauges, valves, diffusers, capacitance diaphragm gauges, and pressure regulators.

Applicants submit that one of ordinary skill in the art would have understood how stack other components into devices that do not include a filter and/or pressure transducer because design of gas flow components is a relatively predictable art. More specifically, one of ordinary skill in the art, at the time United States Patent Application Serial No. 09/261,251, entitled "System and Method for Integrating Gas Components" (the "Gas Components Application") was originally filed, could understand, given a customer's specifications, how to reconfigure a gas component to achieve a number of different fluid flow paths without undue experimentation. See, Declaration of Robert Zeller (the "Zeller Decl.") ¶ 4, attached hereto as Exhibit A. Based on the Gas Components Application and the examples provided therein, those of ordinary skill in the art could understand how to reconfigure gas components to have inlets and outlets such that gas could flow through a gas component to and from another gas component without undue experimentation. See, Zeller Decl. ¶ 5. One of ordinary skill in the art could, therefore, stack a variety of gas components based on the preferred embodiments provided in the Gas Components Application. See, Zeller Decl. ¶ 5. Consequently, the embodiments provided in the Gas Components Application are enabling for stacking a variety of gas components.

#### **B. An Enabled Claim can Read on Inoperative Embodiments**

To the extent the Examiner is concerned that independent Claims 32 and 36 may read on inoperative embodiments, Applicants note that a broad claim is not invalid "just because [it] read[s] on even a very large number of inoperative embodiments since it seems to be conceded

that a person skill in the relevant art could determine which conceived but not-yet fabricated embodiments would be inoperative with expenditure of no more effort than is normally required of a . . . designer . . . ." *In re Cook*, 439 F.2d at 735. Thus, a claim that reads on inoperative embodiments can be enabled so long as one of ordinary skill in the relevant art could determine which embodiments would be operative or inoperative without undue experimentation.

In the present case, one of ordinary skill in the art would understand which gas components could be stacked to produce operative working multifunctional gas components. See, Zeller Decl. ¶ 6. Accordingly, even if the claims read on one or more inoperative embodiments, the claims remain enabled as one of ordinary skill in the art would understand from the Gas Components Application how to form operative multifunctional gas components using a variety of gas components without undue experimentation.

### **C. Applicants Request Allowance of the Claims**

Applicants have submitted the Declaration of Robert Zeller with this Preliminary Amendment. A declaration is itself evidence that must be considered. See MPEP 2164.05. Based on this declaration, Applicants submit that one of ordinary skill in the art, at the time the Gas Components Application was filed, would understand how to stack a variety of gas components and which gas components could be so stacked based on the examples provided in the Gas Component Application without undue experimentation. Therefore, Applicants submit that the preferred embodiments of the present invention are enabling of stacking a variety of gas components and respectfully request that the Examiner allow Claims 32-47.

In view of the above, the claims are considered allowable and full allowance of all the claims is requested. The Examiner is invited to telephone the undersigned (at direct line 512-457-7142) for prompt action in the event any issues remain that prevent the allowance of all the claims pending in this application. The Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account No. 50-0456.

Respectfully submitted,

**Gray Cary Ware & Freidenrich LLP**



John L. Adair  
Reg. No. 48,828

Dated: August 27, 2003

1221 South MoPac Expressway, Suite 400  
Austin, TX 78746-6875  
Tel. (512) 457-7142  
Fax. (512) 457-7001